Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 January 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-46</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-46</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 September 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Amendment B, Paper #8, received 1/5/2004, has been entered into record.

2.   Claims 1-46 are now pending.

Priority

3.   No claim for priority has been made in this application.

4.   The effective filing date for the subject matter defined in the pending claims in this application is 5/11/2001.

Specification

5.   The disclosure is objected to because of the following informalities:

1.   Figure 5 is misrepresented as Figure 4 at Page 14, Line 6, of the present specification. Further, it is noted that Figure 4 is never discussed or properly referenced in the present specification.

2.   Page 1, Lines 5-9 reference a "related" application which has matured into a patent, namely, United States Patent Number 6,442,602. It is required that this fact be incorporated into the present specification, in association with this particular citation, in order to reflect accurate information and allow identification of related documentation readily. Also, this section allegedly references a claim to priority under 35 USC 120, which is improper. No claim to priority has been made in this application.

3.   Page 12, Line 19, specifies an active URL which is not currently permitted in patent applications. USPTO policy does not permit the USPTO to link to any commercial sites

since the USPTO exercises no control over the organization, views or accuracy of the

information contained on these outside sites. See MPEP § 608.01. Further, the attempt to

incorporate subject matter into the patent application by reference to a hyperlink and/or other

forms of browser-executable code is considered to be an improper incorporation by reference.

See MPEP § 608.01(p), paragraph I regarding incorporation by reference.

Appropriate correction is required.

Drawings

6.   The Examiner contends that the drawings submitted on 9/5/2001 are acceptable for

examination proceedings.

Double Patenting

7.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
       Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

8.   Claims 1-46 are rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claims 1-12 of Choudhry (U.S. Patent No. 6,442,602),

hereinafter referred to as Choudhry, in view of Celik (U.S. Patent Number 6,374,259),

hereinafter referred to as Celik.

9.   The present claims prescribe subject matter claimed in the patented document, minimally,

with the further provision for online (electronic) business card information associated with

computer users. Basic searching methodology, indexing, gateway interfacing, HTML delivery,

and HTTP transports are further provided. While expressly providing the majority of the

claimed invention limitations, the Choudhry patented document lends itself perfectly to the

association of information with particular computer network user(s) (e.g., inter alia, Column 4,

Lines 60-63, Column 7, Lines 14-46, Claim 9). Thus, the use of the virtual directory naming

convention for organizing and accessing online information associated with a particular user

would have been obvious to one of ordinary skill in the art at the time of invention armed with

the teachings of the patented invention set forth in Choudhry, in combination with well known

online electronic digital business card storage and usage methodologies.

Claim Rejections - 35 USC § 112

10.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11.   Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as containing subject

matter which was not described in the specification in such a way as to enable one skilled in the

art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention without resorting to undue experimentation.

12.   Claims 1-46 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure

which is not enabling. The details regarding generation and/or all potential functionality related

to resolving of "virtual subdomains", critical or essential to the practice of the invention, but not

included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188

USPQ 356 (CCPA 1976).

13.   The claimed invention describes the "dynamic generation" of "virtual domains" for the

purpose of business card organizing and accessing. It is unclear how this "dynamic generation"

takes place, and how any results of this generation are used to organize or access online

information. Further, the use of CGI scripts for potential resolving of HTML embedded

addresses utilizing the virtual subdomain(s) is not set forth in the specification in sufficient detail

to allow one skilled in the art to make and use the invention as claimed and disclosed. A skilled

artisan would be forced to resort to undue experimentation to make and use the invention given

the level of disclosure set forth in the present specification.

14.   Lastly, Applicant references Choudhry (U.S. Patent No. 6,442,602) in the response,

Paper #8, received on 1/5/2004, Page 12, as allegedly defining the term "virtual subdomain".

However, this document is not incorporated, by reference or otherwise, into the present

specification, and so, any importation of information contained therein, is improper. The term

"virtual subdomain" is not properly defined in the current specification to the extent that one

skilled in the art would be able to utilize it for "organizing and access business cards". Thus, a

clear lack of enablement is present in this application.

15.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16.   Claims 1-46 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17.   Claims 15-46 each use the conjunction "and/or" as amended by Applicant in the response to elaborate upon the term "virtual subdomain", as also argued by Applicant in the response. The use of "and/or" renders these claims indefinite due to the inability to determine which parts of the claims/definition are part of the claimed invention. That is, it is unclear whether the limitation(s) following the phrase "and/or" are part of the claimed invention. Also see, inter alia, MPEP § 2173.05(d). It is further noted that further limiting use of "and/or" is also present, inter alia, in claim 46. All instances of "and/or" must be removed to result in specific, ascertainable scope of the claimed invention.

18.   All the claims use the term "virtual subdomain" which is not defined in such exact terms to associate an ascertainable metes and bounds of the claimed subject matter.

Claim Rejections - 35 USC § 103

19.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

21.   Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chandra

(U.S. Patent Number 6,085,242), hereinafter referred to as Chandra, in view of Celik (U.S.

Patent Number 6,374,259), hereinafter referred to as Celik, or alternatively, over Celik in view of

Chandra.

22.   Chandra disclosed the use of personalized URL logical designators to specify specific

personal associated information for a particular network user. See, inter alia, Abstract,

Column 4, Lines 27-30, and Column 6, Lines 42-45. This information was envisioned to have

been business card information. See, inter alia, Column 4, Lines 17-18, and Column 5,

Lines 28-32. The database housing this information was optionally part of a web server, fully

incorporating the transport protocols and hypertext formatting capaibilities as known in the art.

See, inter alia, Column 4, Lines 8-12. Specifically, the use of "virtual subdomains" was

expressly provided and utilized to reference database information. See, inter alia, Column 5,

Lines 8-11, and Column 6, Lines 5-18. Lastly, the stored database information correlated

directly to a dynamically generated logical designation, e.g., URL. See, Column 6, Lines 42-45.

23.   Since Chandra expressly disclosed the provision for electronic business card storage and

access, one of ordinary skill in the art would have been motivated to search the related arts for

electronic business card teachings compatible with the Chandra sysem.

24.   In the same art of information organization, storage, access, and network retrieval, Celik

disclosed various network database application programming interfaces (Column 5, Lines 45-50)

serving to organize and update business card entries (inter alia, Column 1, Lines 46-49). The

system was functional to search business card listings in order to query/filter the information

within the database utilizing typical network mechanisms. See, inter alia, Column 6, Line 66

through Column 7, Line 20.

25.   The system of Chandra suggestively using a database of business card information as

disclosed would have been obviously modified with the business card information database

system set forth by Celik in order to result in a system fully utilizing the business card database

as directly suggested by Chandra as enabled by Celik. Conversely, the central storage,

management, access, and retrieval of business card database information set forth by Celik,

generating a unique user identifier (inter alia, Column 7, Lines 22-31) remained silent as to how

this assignment was effected. An ordinary artisan working with the Celik system at the time of

invention would have been motivated to explore the related arts for teachings resulting in a

generation of unique user assignment(s), as disclosed by Chandra in, inter alia, Column 6,

Lines 9-16, also dealing directly with business card network user data. Thus, it would have been

obvious to one of ordinary skill in the art at the time of invention to combine the teachings set

forth by Chandra and Celik to result in a business card database organization, access, and

retrieval system using typical, known network software elements, database mechanisms,

information transport, and display format processing.

        Claims 1-46 are rejected.

26.   Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Choudhry

(U.S. Patent Number 6,442,602), hereinafter referred to as Choudhry, in view of Celik (U.S.

Patent Number 6,374,259), hereinafter referred to as Celik, or alternatively, over Celik in view of

Choudhry.

27.   Choudhry disclosed the use of virtual subdomain name usage using resolving features not

handled by conventional domain name services (DNS). See, inter alia, Abstract, Column 4,

Lines 19-38, and Column 6, Lines 10-50. Choudhry further disclosed the use of known, typical

network scripts to map virtual subdomains to director(ies) and/or other logical designations,

themselves resolvable into particular address(es) for information transfer. See, inter alia,

Column 3, Lines 22-31, Column 4, Lines 40-63, and Column 7, Lines 15-46. It is noted that

Applicant asserts complete equivalence between the terms used in the claimed invention and the

Choudhry disclosure in the response, Paper #8.

28.   While Choudhry disclosed the invention substantially as claimed, Choudhry did not

specifically disclose the use of online business cards or the use of database functions to organize,

store, access, or otherwise manipulate online business card information. The system of

Choudhry was disclosed in an open-ended manner, allowing implementation of the "virtual

subdomain" logical address designation to reference and manage arbitrary information sets. See,

inter alia, Column 1, Lines 56-67, and Column 7, Lines 47-57. Thus, an ordinary artisan at the

time of invention would have been motivated to search the related networking arts to find

suitable information storage systems which would benefit from the system as disclosed by

Choudhry.

29.   In the same art of network information addressing, storage, and retrieval, Celik disclosed various network database application programming interfaces (Column 5, Lines 45-50) serving to organize and update business card entries (inter alia, Column 1, Lines 46-49). The system was functional to search business card listings in order to query/filter the information within the database utilizing typical network mechanisms. See, inter alia, Column 6, Line 66 through Column 7, Line 20.

30.   Since Celik provided a specific type of information storage and retrieval system, it would have been obvious to modify the system of Choudhry with the teachings of Celik in order to effect network information storage, addressing, and retrieval in an efficient and intuitive manner of information having use to network users. See, inter alia, Choudhry, Column 4, Lines 19-64, and Celik, Columns 5-7.

31.   Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the addressing system of Choudhry with the business card addressing and retrieval method(s) of Celik in order to result in a fully operational online informational delivery system. Likewise, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the business card information management system of Celik with the intuitive addressing scheme set forth by Choudhry in order to provide a logical, low overhead method for generating logical information storage designations for subsequent use in search and information retrieval.

        Claims 1-46 are rejected.

Response to Arguments

32.   The arguments presented by Applicant in the response, Paper #8, received on 1/5/2004,

are not considered persuasive.

33.   Applicant asserts that "[the prior art] does not mention the term "virtual subdomain", a

key term which formed the basis of this application's specifications and original [] claims" in the

Response, Paper #8, received 1/5/2004, Page 10, Lines 6-8. While Applicant is entitled to be his

own lexicographer, it is noted that functionality is at hand, not the presence or failure of the

terms in the claims. The assertion of failure of pieces of prior art to precisely describe the

claimed invention using the same terms is irrelevant. The true issue is the disclosure of the

functionality described by the claimed terms. Applicant admits complete and full disclosure of

identical functionality by Choudhry at response, Paper #8, received on 1/5/2004, Pages 12-14.

Likewise, this general functionality was well known in the prior art in other sources. See, inter

alia, enclosed patents, e.g., U.S. Patent Numbers 5,812,769, and 6,301,617. Likewise, the notion

of electronic business cards were also notoriously well known in the art at the time of invention,

further associated in DNS resource records (RRs). See, inter alia, enclosed vCard

specification(s), and RFC 2426.

34.   Applicant further asserts "reduction administrative cost and improved accuracy" through

use of the claimed invention over the prior art of record.

        1.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

functionality acting to reduce cost and improve accuracy [assumedly of name resolving and

information retrieval) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2.   In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3.   Applicant's arguments may fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Also, Applicant's arguments may fail to comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

35.   Finally, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

36.   The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

37.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750.

The Examiner can normally be reached on Monday-Friday from 9am to 4pm. If attempts to

reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jack Harvey, can

be reached at (703) 305-9705. The fax phone number for this Group is (703) 872-9306.

Inquiries of a general nature relating to the general status of this application or proceeding should

be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

MARC D. THOMPSON

MARC THOMPSON

PRIMARY EXAMINER

Marc D. Thompson
Primary Examiner
Art Unit 2144